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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056752
Party	Plaintiff Melvin Hale
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	02/04/2013
Attachments	PTC with Exhibits.pdf ( 11 pages )(565630 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
The Trademark Trial and Appeal Board**

In the matter of U.S. Registration 3,665,652,



For the mark  
Registered on the Principal Register on August 11, 2009.

Melvin Hale,

Petitioner,

vs.

Artful Color, Inc.,

Registrant.

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Cancellation No. 92056752

**AMENDED PETITION TO CANCEL**

Petitioner, Melvin Hale (hereinafter "Petitioner"), a an individual, located and doing business at 3175 South Sepulveda Blvd, Apt 303, Los Angeles, California, 90034, believes that he is and will continue to be damaged by the continued registration of U.S. Registration 3,665,652 for the mark



(hereinafter, "Registrant's Mark") and, accordingly, hereby petitions this honorable tribunal to cancel the same pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111(b).

**Grounds for Cancellation**

As grounds for the instant Petition to Cancel, it is alleged that:

1. The continued registration of Registrant Artful Color, Inc.'s (hereinafter "Registrant") mark as more fully displayed in U.S. Registration No. 3,665,652 would be likely to cause confusion with Petitioner's mark PIX2CANVAS which retains priority of use over Registrant's Mark by virtue of its prior use in commerce in the United States; and

2. Registrant Artful Color, Inc. (hereinafter "Registrant") perpetrated fraud upon the United States Patent and Trademark Office (hereinafter "Office") by a willful and intentional submission of material false information to procure the registration of the mark.

## **Statement of Facts**

### **Count 1: Priority of Use**

In support for the instant Petition to Cancel, it is alleged that:

1. Petitioner is the owner of the mark PIX2CANVAS (hereinafter "Petitioner's Mark") used on or in connection with printing of scanned or digitally acquired images on canvas or other print media, using wide format printing technology.
2. Petitioner first used Petitioner's Mark in connection with the above-identified services in interstate commerce on or about April 17, 2001.
3. Petitioner's use of Petitioner's Mark in connection with the above-identified services has been continuous since on or about April 17, 2001.
4. Petitioner has invested significant sums of money in the promotion of Petitioner's Mark and the Petitioner's services in the United States.
5. As a result of the aforesaid, Petitioner has developed a valuable reputation and goodwill in its mark and has achieved a following among the relevant consuming public prior to the filing, registration and/or priority date of Registrant's application to register the mark identified more fully in U.S. Registration No. 3,665,652.
6. On June 19, 2012, Petitioner filed an application to register Petitioner's Mark used on or in connection with printing of scanned or digitally acquired images on canvas or other print media, using wide format printing technology in International Class 40. The application received Trademark Application No. 85/655,901.
7. By Office Action dated August 14, 2012, the examining attorney issued an initial refusal to register Petitioner's Mark based upon the examining attorney's opinion that, if registered, Petitioner's mark would be likely to create a likelihood of confusion with Registrant's registered mark U.S. Registration No. 3,665,652, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).
8. The Office Action dated July 27, 2011 referenced hereinabove was Petitioner's first notice that Registrant was using Registrant's Mark in the United States.

9. Upon information and belief, Registrant first used Registrant's Mark in connection with the services covered by its registration in the United States on February 1, 2008.

10. As such, Petitioner's rights in Petitioner's Mark have priority of use over Registrant's rights in Registrant's Mark, U.S. Registration No. 3,665,652, inasmuch as Petitioner commenced its use of Petitioner's Mark in connection with its services in interstate commerce prior to the filing, registration, and/or priority of use date of the Registrant's registration and use of Registrant's Mark.

11. The continued registration of Registrant's Mark confers upon Registrant rights to which it is not entitled and is inconsistent with the prior established rights of Petitioner in Petitioner's Mark.

12. By reason of the foregoing, Petitioner will be damaged by Registrant's continued registration insofar as Petitioner's mark will not be permitted to register while Registrant's registration remains in effect.

#### **Count 2: Fraud**

13. Registrant contends that it is the owner of the following mark:



, U.S. Registration No. 3,665,652, used in connection with "Digital printing of customer supplied photos onto canvas" in International Class 40.

14. On or about April 24, 2008 Registrant filed its use-based application with the Office seeking to register the Mark in connection with the aforementioned services. The application received Serial No. 77/456,787.

15. Petitioner provided extensive information about his company and products to Eastman Kodak on or about November 29, 2005. *See* exhibit A.

16. Upon information and belief, Registrant declared on its April 24, 2008 use-based application that to its knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near

resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

17. Upon information and belief, the president of Registrant's company, Damon Rando was aware of Petitioner's Mark, and services when he was previously employed at Eastman Kodak. *See* Exhibit B.

18. As such, Registrant knew of the use of Petitioner's Mark and therefore perpetrated fraud upon the Office.

### CONCLUSION

19. Petitioner believes that it will be damaged by Registrant's continued registration of the instant Mark insofar as the instant registration confers upon Registrant rights to which it is not entitled which may be used to adversely affect Petitioner's right to use its mark and other similar designations.

20. WHEREFORE in consideration that Petitioner's rights in Petitioner's Mark have priority over Registrant's rights in Registrant's mark and, Registrant's registration for its Mark was garnered through fraud and material misstatements to the Office Petitioner respectfully requests that US. Registration No. 3,665,652 be cancelled on the grounds and for the reasons set forth hereinabove.

Respectfully submitted this 4<sup>th</sup> day of February, 2013.

The Trademark Company, PLLC

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Counsel for Petitioner

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Cancellation No. 92056752

Certificate of Service

I HEREBY CERTIFY that a true and accurate copy of the foregoing *Petition to Cancel* was served this 4<sup>th</sup> day of February, 2013 upon the Registrant via first class mail at the address listed on the TARR database as reported this day as follows:

Artful Color, Inc.  
2501 Schieffelin Road  
#128  
Apex, NC 27502

And a copy to:

Keller, Finley J.  
12341 Woods Road  
Wilton, CA 95693-8506

/Matthew H. Swyers/  
Matthew H. Swyers

**Email Exchange with Kodak in 2005**

**Referencing the Information Packet Sent by Melvin Hale**

**(How Damon Rando Came to Know About Pix2Canvas)**

**From:** "barbara.smith@kodak.com" <barbara.smith@kodak.com>

**To:** [reefresh@yahoo.com](mailto:reefresh@yahoo.com) [1]

**Sent:** Thursday, December 1, 2005 3:58 AM

**Subject:** Re: DIgital Imaging opportunity

Melvin

I have forwarded your email on to a few individuals inside Kodak and have asked that they contact you directly should they have an interest in pursuing this proposal further.

Barbara Smith  
Director, Quality and Business Strategy Development  
Worldwide Purchasing  
Eastman Kodak Company

Phone: 585-724-2131

Fax: 585-724-2848

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Mel <[reefresh@yahoo.com](mailto:reefresh@yahoo.com)>

11/29/2005 11:00 AM To Barbara Smith <[barbara.smith@kodak.com](mailto:barbara.smith@kodak.com)>

cc

Subject DIgital Imaging opportunity

Hi Barbara,

Very nice to make your acquaintance this morning. Kodak is a large place, and I appreciate your help in routing this request for information to the appropriate group. I have cut & paste the basic requirements below.

My client is a prestigious Fortune 100 corporation. I have an exclusive opportunity to present this company with a major digital imaging solution. The objective of this solution is to allow agents of this company to procure images from digital cameras on a daily basis, and to archive these images for potential future analysis. My background in digital imaging and database management is extensive, and my access to upper management is unique and direct.



The size of the company and the number of field agents is understandably large; hence my intention is to obtain the contract for the job, and to outsource the solution to an organization with the technical and business resources and experience to ensure success. The next meeting I have set with management is on December 19, 2005. Going into this meeting I would like to have the technical outline of a solution in hand. We have divided the country into five regions for this solution, and I intend to test the solution in one of those regions. Here are the metrics for that one region:

1200 agents

30 pictures daily per agent (36,000 images/day)

Approx. 100-200K per image (3.6 to 7.2 Mb/day)

Each agent will require a digital camera. The camera doesn't need to be high resolution, but it should be fairly rugged and easy to operate. A built-in flash is important. The solution should involve a simple mechanism for uploading images and related data to an online database.

These numbers are conservative. Bear in mind that on a national basis, these numbers will be much higher. We will standardize on the camera, and would ultimately need about 5,000 cameras.

I would expect the solution to be structured in a per image format, i.e. 5¢ per image, with a separate breakout for the camera equipment, but you can structure it in any format which makes sense to you.

This is a groundbreaking solution, not only for this corporation, but also for the entire industry. It has not been previously attempted because of the scope and complexity. Relatively inexpensive digital cameras and inexpensive storage have now made this feasible. Once this solution is proven, my goal is to approach other companies who share similar needs.

If Kodak is not the right home for this opportunity, I would appreciate any references you could provide.

Sincerely,

Melvin Hale

[refresh@yahoo.com](mailto:refresh@yahoo.com)[2]

916-806-3162





**Damon Rando**

**MyPix2Canvas.com**

**Raleigh-Durham, North Carolina Area | Photography**

### Damon Rando's Overview

**Current** President at MyPix2Canvas by Artful Color, Inc.

**Past** National Account Manager at Eastman Kodak  
Director of Business Development at Ergosoft  
Founder at Precision Color  
[see all ▼](#)

**Education** Louisiana Tech University  
Louisiana State University

**Recommendations** 3 people have recommended Damon

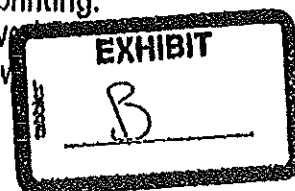
**Connections** 500+ connections

### Damon Rando's Summary

Skilled in sales, business development, marketing, channel/vendor management. Developed and managed sales strategies, customer prospecting, business planning, executive briefings, and marketing collateral for color publishing technologies. A visionary with in-depth technical skills and the ability to dynamically communicate.

High-energy professional with sales and business development success who consistently exceeds the status quo.

- Far exceeded sales goals four years in a row 2005 – 175%, 2006 – 169%, 2007 – 206%, 2008 – 118%
- Extensive sales and market knowledge of the digital print and photo market.
- Led effort to break Kodak into photo press market including sales, marketing, and technical.
- In-depth knowledge of inkjet technology and markets including art, photo, and print-on-demand. Includes detailed understanding of sustainability issues in inkjet printing.
- Pioneer and industry speaker on color management technology and digital workflow.
- Took struggling VAR channel from \$15 million to \$75 million in sales within two years.



Talented team builder with a complementary blend of creative, sales, technical, quality, and engineering acumen.

- Led efforts to grow brand awareness, drive customers to consideration and purchase in target markets.
- Speaker at national events including Seybold, MacWorld, On Demand, Publish, and Graph Expo. Speaking engagements also included over 100 other events.
- Satisfied clients include industry leaders Apple, Full Color, Miller's, Card Café, American Color, People magazine, Time magazine, Sony Records, Simon & Schuster, AP News, and others.
- Developed strategic alliances with industry partners including Xerox, Epson, Kodak, Nikon, and HP.
- Authored and lead development of articles and industry documents including feature article in Digital Output magazine, how-to's, white papers, manuals, and interactive tutorials.

#### **Specialties**

- Highly skilled in consultative sales
- Exceptional knowledge in Photo Publishing market
- Very skilled in color science and color management
- Very knowledgeable in digital print and photo technology

### **Damon Rando's Experience**

#### **President**

**MyPix2Canvas by Artful Color, Inc.**

December 2010 – Present (2 years 2 months)

Leading efforts to grow MyPix2Canvas.

This includes the market analysis, market share strategies, website development, and production strategies.

MyPix2Canvas has now shipped over 41,000 orders and over 60,000 canvases. We are one of LivingSocial's top performing national deals and have run deals in more than 150 markets across the US.

#### **National Account Manager**

**Eastman Kodak**

Public Company; 500+10,000 employees; EIC; Printing Industry

January 2005 – March 2009 (4 years 3 months)

- Opened new market for Kodak NexPress in personalized photo books, cards, and calendars. Resulted in growing business to over \$20 million in annual revenue.
- President's Club level of sales all four years and achieved well over 100% of quota each year. Quota was doubled or tripled each year.

## **Director of Business Development**

### **Ergosoft**

Privately Held; 11-50 employees; Computer Software Industry

2002 – 2003 (1 year)

ErgoSoft US is the US division of a Swiss-based software company that provides software for graphics production. Responsible for recruiting dealers and all aspects of business development. Working with over one hundred dealers and prospective dealers across the US and Canada.

## **Founder**

### **Precision Color**

1999 – 2002 (3 years)

- Led startup and created competitive advantage in regional market, leading to sale of \$850K company.
- Successfully marketed technology to creative services of mid-size advertising agencies and Fortune 1000 companies including on demand color and variable data printing.
- Recruited to maintain key accounts and client relationships for acquiring company.

## **Business Development Executive**

### **Apple Inc.**

Public Company; 10,001+ employees; AAPL; Consumer Electronics Industry

1996 – 1999 (3 years)

- Provided executive briefings and demonstrated proof-of-concept to Fortune 1000 customers.
- Apple's key closer for color publishing technology.
- Apple's lead industry speaker on color and digital publishing technology.

## **Marketing Manager**

### **Apple Inc.**

Public Company; 10,001+ employees; AAPL; Consumer Electronics Industry

1994 – 1996 (1 year)

- Managed senior level relationships with key customers including People magazine, Time magazine, Simon & Schuster, Sony Records, AP News, McCann-Erickson, JC Penney, and many others.
- Led development of all seminars, training classes, and educational materials for color technology.

## **VAR Channel Manager**

### **Apple Inc.**

Public Company; 10,001+ employees; AAPL; Consumer Electronics Industry

1991 – 1993 (2 years)

- Grew Apple USA's direct VAR channel by 400%; restructured program, including Policies & Practices, applications, and contracts. Also established annual VAR executive briefing.
- Developed new markets and expanded existing markets into graphic workstations, video, photographic, electronic medical devices, stock market trader stations, military radar systems and engineering analyses.

## **Lead Escalation Engineer**

### **Apple Inc.**

Public Company; 10,001+ employees; AAPL; Consumer Electronics Industry

1988 – 1991 (3 years)

- Spearheaded resolution of major product reliability issue that led to reimbursement by OEMs and continued sales growth.

## **Damon Rando's Skills & Expertise**

Digital Printing   Digital Imaging   Product Marketing   Color Management  
Strategic Partnerships   Product Management   Solution Selling  
New Business Development   Product Development   Business Development  
B2B   Direct Sales   Marketing Strategy   Cross-functional Team Leadership  
Sales Management   Account Management   Multi-channel Marketing  
Go-to-market Strategy   Start-ups   Project Management

## **Damon Rando's Education**

### **Louisiana Tech University**

Bachelor of Applied Science (BASc), Electrical and Electronics Engineering

1982 – 1985